

AMENDMENT
U.S. Appln. No. 10/811,987

REMARKS

Upon entry of the claim amendments, Claims 1 and 4-17 will be all the claims pending in the application.

Applicants have amended Claim 1 by incorporating therein the subject matter of Claims 2 and 3. Claims 2 and 3 have been canceled.

Claim 7 has been amended so that it depends from Claim 1, in view of canceled Claim 2.

No new matter has been added.

Referring to Section No. 2 of the Office Action at pages 2 and 3 of the Office Action, Claims 1-10 and 12-14 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,746,558 ("US '558").

Applicants respectfully traverse.

Amended Claim 1 is directed to a magnetic recording medium. Claim 1 requires the magnetic recording medium to comprise, in order, a non-magnetic support, a radiation-cured layer formed by applying a layer comprising a radiation curing compound and curing by exposure to radiation, a non-magnetic layer having a non-magnetic powder dispersed in a binder, and a magnetic layer having a ferromagnetic powder dispersed in a binder. Thus, the invention of Claim 1 comprises three layers on a support.

US '558 does not teach a magnetic recording medium containing three layers on a support. As acknowledged by the Examiner at page 3 of the Office Action, US '558 does not teach the use of a non-magnetic layer containing non-magnetic powder and binder between the magnetic layer and the radiation-cured layer.

The Examiner has taken the position at page 3 of the Office Action that it would have been obvious to use an intermediate layer in order to enable production of thinner magnetic layers which allow for higher density recording.

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Applicants respectfully disagree. The Examiner's position with respect to modifying US '558 to include an intermediate layer therein is unreasonable.

In this regard, the mere possibility that the prior art may be modified so as to arrive at the claimed invention does not render obvious the invention unless the prior art suggested the desirability of the modification. The suggestion to modify must be "clear and particular." In re Sang Su Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433-1434 (Fed. Cir. 2002); Winner Int'l Royalty Corp. v. Ching-Rong Wang, 202 F.3d 1340, 1348-1349, 53 USPQ2d 1580, 1586-1587 (Fed. Cir. 2000).

In the §103(a) of Claims 1-10 and 12-14 over US '558, the Examiner has not identified any mention at all in US '558, let alone a clear and particular suggestion therein, to modify the magnetic recording medium of US '558 to include a non-magnetic layer having a non-magnetic powder dispersed in a binder, as recited in amended Claim 1 (and as originally recited in Claim 2). US '558's complete silence on the matter precludes it from providing the required motivation under §103. Reconsideration and withdrawal of the §103(a) rejection based on US '558 is respectfully requested.

Referring to Section No. 3 at pages 3 and 4 of the Office Action, Claims 1-11 and 13-15 are rejected under **35 U.S.C. § 103(a)** as being unpatentable over U.S. Patent No. 6,074,724 ("US '724") in view of U.S. Patent No. 4,619,856 ("US '856").

Applicants respectfully traverse.

As mentioned above, Claim 1 requires the magnetic recording medium to comprise, in order, a non-magnetic support, a radiation-cured layer formed by applying a layer comprising a radiation curing compound and curing by exposure to radiation, a non-magnetic layer having a non-magnetic powder dispersed in a binder, and a magnetic layer having a ferromagnetic powder dispersed in a binder. Thus, the invention of Claim 1 comprises three layers on a support.

Furthermore, Claim 1 requires the inorganic powder in the radiation-cured layer to be selected from the group consisting of a metal oxide, a metal carbonate, a metal sulfate, a metal nitride, a metal carbide, a metal silicide, and a metal sulfide.

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The combination of US '724 in view of US '856 does not lead one of ordinary skill in the art to the presently claimed three-layer structure and the selection of the specific inorganic powder.

US '724 does not teach a radiation-cured layer as an adhesive layer. Column 14, lines 33-36. US '724 is directed to a magnetic recording medium having a layer structure comprising a support, an undercoating layer and a magnetic layer. US '724 teaches two layers on a support.

On the other hand, US '856 is directed to a magnetic recording medium having a layer structure comprising a support, a non-magnetic intermediate layer and a magnetic layer. US '856 also teaches two layers on a support, and the non-magnetic intermediate layer is a radiation-cured layer. Column 2, lines 17-31, and working examples 1-6. The ingredient of Example 1 of US '856 is powdered polyethylene terefluoride, which is not an inorganic powder. Furthermore, the magnetic layer of US '856's Examples 1-5 is not provided by coating but by vapor deposition.

Thus, the combination of US '724 in view of US '856 does not lead one of ordinary skill in the art to the presently claimed three-layer structure and the selection of the specific inorganic powder.

In addition, the specification contains objective evidence of patentability which rebuts any alleged case of *prima facie* obviousness. Specifically, Applicants direct the Examiner's attention to the results from the Examples (which fall within the scope of the invention) and Comparative Examples (which fall outside the scope of the invention) presented in Table 1 at page 50 of the specification. Table 1 demonstrates that magnetic recording mediums according to the invention achieve unexpectedly superior results.

For the foregoing reasons, reconsideration and withdrawal of the §103(a) rejection based on US '724 in view of US '856 is respectfully requested.

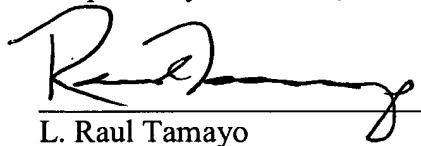
Reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be

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best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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